

PATENT APPLICATION



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

#13

In re the Application of

Andrés RIVERA et al.

Group Art Unit: 1772

Application No.: 09/353,592

Examiner: S. Hon

Filed: July 15, 1999

Docket No.: 101054

For: APPLICATOR FOR A POLYMERIZABLE MONOMER

REPLY BRIEF

Director of the U.S. Patent and Trademark Office
Washington, D.C. 20231

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Sir:

The following remarks are directed to the new points of argument raised in the
Examiner's Answer dated February 6, 2002.

At page 2 of the Examiner's Answer, the Examiner states that "[t]he brief does not
contain a statement identifying the related appeals and interferences which will directly affect
or be directly affected by or have a bearing on the decision in the pending appeal is contained
in the brief." However, this statement indicates a clear failure of the Examiner to properly
consider Applicants' submissions. In fact, the Appeal Brief does contain the required
statement. See Appeal Brief at page 1, where Applicants expressly stated:

B. Statement of Related Appeals and Interferences

There are presently no appeals or interferences, known to Appellant,
Appellant's representative, or the Assignee, which will directly affect or be directly
affected by or have a bearing upon the Board's decision in the pending appeal.

The Examiner's oversight on this procedural issue only underscores Applicants' assertions that the Examiner has failed to properly consider and apply the substantive teachings of the cited references.

At pages 5 and 7 of the Examiner's Answer, the Examiner for the first time clearly argues that the claimed invention would have been obvious over Leung, because Leung teaches that the rate modifier should be separated from the polymerizable or cross-linkable monomer material. The Examiner argues that because Leung teaches such separation, it would have been obvious to apply the rate modifier either to the inner surface of the outer container, as expressly disclosed in Leung, or on the outer surface of the inner container, as presently claimed. Applicants disagree.

The Examiner argues that such a modification of Leung would have been obvious, because the rate modifier would still remain in the same space between the inner and outer containers, and would remain separated from the polymerizable or cross-linkable monomer material. However, these arguments ignore the fact that the modification must have been obvious from the reference itself. The mere fact that the Examiner can first look at Applicants claims, and then reverse engineer the claimed invention in the context of the cited reference, is improper. Rather, for all of the reasons set forth in Applicants' Appeal Brief, Leung nowhere teaches or suggests that the rate modifier should instead be incorporated into the applicator device, by coating it on the outer surface of the inner container, as claimed. Because Leung does not teach or suggest modifying the disclosed applicator in such a manner, Leung cannot have rendered obvious the claimed invention.

At page 7 of the Examiner's Answer, the Examiner maintains the argument that the phrase "lined or coated" in Leung was intended to cover two different embodiments, not merely two alternative words for the same embodiment. However, this assertion is incorrect for all of

the reasons set forth by Applicants in the Appeal Brief. Still further, the Examiner's assertion is incorrect based on the clear language of the reference.

As pointed out in the Appeal Brief, Leung describes the embodiment as follows:

the applicator container may be lined or coated with the initiator or the initiator may be stored in a compartment separate from the polymerizable and/or cross-linkable material within the applicator container. For example, in the device of FIG. 3, the initiator may be coated on the internal surface of body 200.

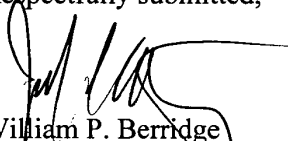
Col. 10, lines 43-53. According to the Examiner, this passage must be read to mean that the initiator can be "lined" on the inner surface of the outer container, or "coated" on the outer surface of the inner container. However, this interpretation of the phrase is contrary to the express language of Leung.

Rather, Leung states that "the applicator container may be lined or coated with the initiator" (emphasis added). Leung nowhere mentions applying the initiator to the inner container, but only describes applying the initiator to the applicator, i.e., outer, container. Thus, according to the Examiner's interpretation, Leung would have to be disclosing that the initiator could be lined on the inner surface of the outer container, or could be coated on the outer surface of the outer container. This interpretation would still match with the Examiner's assertion that Leung teaches that the initiator be separated from the polymerizable or cross-linkable monomer material.

Since coating the initiator on the outer surface of the outer container would be generally unworkable and ineffective, this is further evidence that the words "lined" and "coated" were used in Leung to describe the same embodiment not to describe different embodiments, as asserted by the Examiner. This is again further evidence that the Examiner has merely first looked at Applicants' claimed invention, and has then proceeded through contortions of the disclosure of Leung to reverse engineer the claimed invention.

It is respectfully submitted that the remaining points of argument set forth in the Examiner's Answer were fully addressed in Appellant's Appeal Brief. For the reasons set forth herein and in the Appeal Brief, it is respectfully requested that the rejections of the claims under 35 U.S.C. §103(a) be reversed.

Respectfully submitted,



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WPB:JSA

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